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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,170	03/11/2004	Robert G. Arsenault	20009/PD-980128 A	5118

7590 11/01/2005
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EXAMINER

HOYE, MICHAEL W

ART UNIT PAPER NUMBER

2614

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/798,170	ARSENAULT ET AL.	
	Examiner	Art Unit	
	Michael W. Hoye	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-43 (based on a provisional rejection) is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 40-42, in Fig. 2; and 112, in Fig. 3. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 33 is objected to because of the following informalities: the claim appears have a typographical error and should be dependent on claim **32**, not claim 33. Appropriate correction is required.

Double Patenting

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3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 24-43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 7-8, 11, 13-16 and 18-19 of U.S. Patent No. 6,728,966. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 24-43 and claims 1-5, 7-8, 11, 13-16 and 18-19 of USPN 6,728,966, are both directed to a method and apparatus for storing digital content records used to create informational displays in an electronic television program guide. Independent claims 24 and 35 differ from patented claims 1 (along with dependent claims 25-27) and 13 (along with dependent claims 36-38), respectively, in that the claims are slightly broader in scope. More specifically, the claimed "receiver" in independent claims 24 and 35 of the application claims is an obvious broader equivalent of the claimed "satellite receiver" in independent claims 1 and 13 of the patent, and the remainder of independent claim 24 and dependent claims 25-27 are almost identical to independent claim 1 of the patent, also independent claim 35 and dependent claims 36-38 are almost identical to independent claim 13 of the patent respectively.

In addition to, dependent claims 28-34 equate to patented claims 3-5, 2, 7-8 and 11, of USPN 6,728,966, respectively.

Finally, dependent claims 39-43 equate to patented claims 15-16, 14 and 18-19, of USPN 6,728,966, respectively.

Although the patented independent claims 1 and 13 are slightly more specific or detailed than the corresponding claims in the application, the minor variation in wording (i.e. "satellite receiver" vs. "receiver") does not affect the scope of the claimed method or apparatus, and it would have been obvious to one of ordinary skill in the art to have made the minor variations in the claims as described above. The portion of the specification in patent 6,728,966 that supports a "receiver" for receiving a first content record... that would anticipate claims 24 and 35 is met by col. 1, lines 29-35; col. 3, lines 13-53; and col. 4, lines 7-22.

Allowable Subject Matter

5. The following is a statement of reasons for the indication of allowable subject matter: The prior art, alone or in combination does not teach or fairly suggest the claimed method and apparatus of claims 24-43 for storing digital content records used to create informational displays in an electronic television program guide.

As for independent claims 24 and 35, the prior art, alone or in combination, does not teach or fairly suggest an apparatus and a method for storing digital content records used to create informational displays in an electronic television program guide comprising a receiver for receiving a first content record; a memory for storing the first content record; and a control circuit operatively coupled to the receiver and the memory, wherein the control circuit is configured to determine (a) if the first content record is new; (b) if the first content record is associated with a new label that categorizes the first content record; and (c) if the first content

record is associated with a title that categorizes the new label. As for the most pertinent prior art of record, the Etheredge (USPN 6,172,674) reference discloses an apparatus and method for storing digital content records used to create informational displays in an electronic television program guide. The claimed [satellite] receiver for receiving a first content record is met by client computer 100 through which the user is connected to a satellite dish (col. 5, lines 25-39). The claimed memory for storing the first content record is met by DRAM 134, in Figure 2. The claimed control circuit operatively coupled to the receiver and the memory is met by processor 130 as shown in Figure 2 (col. 3, lines 59-60, col. 4, lines 44-52), the components are connected directly to processor 130 or via a bus 162 (col. 5, lines 7-9). Etheredge discloses various pointers for records associated with electronic program guide display information (see col. 6, lines 46-48, col. 7, lines 18-25 and col. 10, line 63 – col. 11, line 7. However, Etheredge does not explicitly disclose (a)-(c) as recited above.

An additional reference, Williams et al (USPN 6,157,411), discloses a [satellite] receiver (satellite input 126 in Fig. 1 and DSS 232 in Fig. 2, see col. 3, line 8, col. 4, lines 2-3, 10 and 48, and col. 5, lines 33-37) for receiving content data such as records, traits or items (col. 5, lines 23-25, 33-37, 62-67 and col. 6, lines 28-54), that includes memory and mass storage (see Figs. 2 & 5), where the control circuit or processor dynamically generates records with additional or new fields to accommodate new traits that may have been received for a particular item (see col. 6, lines 53-67, col. 7, lines 21-35, col. 8, lines 1-5, col. 9, line 64 – col. 10, line 2 and 15-39). However, Williams et al does not disclose specifically disclose (a)-(c) as recited above. One of ordinary skill in the art would not have been led to modify the Etheredge reference and/or Williams et al reference to make all of the additional claimed features of the applicant's

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invention. The Etheredge and Williams et al references do not teach or fairly suggest an apparatus and a method for storing digital content records used to create informational displays in an electronic television program guide specifically comprising (a)-(c) as described above. In the applicant's invention, the particular features described above are disclosed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Coleman et al (USPN 5,844,620) – Discloses a method and apparatus for displaying an interactive television program guide.

Donnelly, Daniel B. (USPN 6,460,181) – Discloses the availability of a new information service is publicized by displaying an icon in an EPG when the presence of a new information service is detected. A list of new services is then displayed responsive to a user command. When one of the new services is selected from the list, a description of the selected new service is displayed instead of the list.

Hendricks et al (USPN 5,798,785) – Discloses a terminal for suggesting programs offered on a television program delivery system.

Hite et al (USPN 5,774,170) – Discloses a system and method for delivering targeted advertisements to consumers.

Kohno et al (USPN 6,462,784) – Discloses an apparatus and method for displaying program contents (EPG).

Nishikawa et al (USPN 6,348,932) Discloses a DSS/WebTV receiver for providing two different types of services in a menu.

Nishikawa et al (USPN 6,481,010) Discloses a DSS/WebTV receiver including a TV planner or electronic program guide.

Noguchi et al (USPN 6,426,779) – Discloses a method and apparatus for providing favorite station and programming information in a multiple station broadcast system.

Roop et al (USPN 6,216,265) – Discloses a system and method for transmitting and utilizing electronic program guide information.

Schein et al (USPN 6,133,909) – Discloses a method and apparatus for searching a guide using program characteristics.

Seth-Smith et al (USPN 4,829,569) – Discloses communication of individual messages to subscribers in a subscription television system.

Shoff et al (USPN 6,240,555) – Discloses an interactive entertainment system for presenting supplemental interactive content together with continuous video programs.

Slezak, Robert J. (WO 97/12486 A1) – Discloses an interactive multi-media system having a video server for providing a primary video program interleaved with secondary multimedia programming and a database for storing information about a viewer and the content of the primary video program.

Watts et al (USPN 5,671,411) – Discloses a method of searching an audio/visual programming database using selected criterion having implicit logical operation.

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Yoshinobu et al (USPN 5,686,954) – Discloses a program information broadcasting method program information display method, and receiving device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael W. Hoyer whose telephone number is **571-272-7346**.

The examiner can normally be reached on Monday to Friday from 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller, can be reached at **571-272-7353**.

Any response to this action should be mailed to:

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

Michael W. Hoyer
October 27, 2005


JOHN MILLER
SUPERVISORY PATENT EXAMINER
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